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## FACSIMILE COMMUNICATION

To: Examiner Davi  
Fax #: 571-273-0854  
Re: U.S. Patent App. # 09/700,712 Carlin Et Al  
From: Richard Fichter  
Total pages: 2

Date: September 20, 2004

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Thank you, BACON &amp; THOMAS, PLLC.

## Message:

We are enclosing sheet 5 as requested. Please let us know if you need any further assistance. Thank you.

**INTERNATIONAL PRELIMINARY  
EXAMINATION REPORT - SEPARATE SHEET**

International application No. PCT/EP99/03509

from the strains mentioned in claim 16, the subject-matter of claim 16 appears to be novel.

However, in view of D2, in combination with the facts that neither the method for producing the *thyA*' strains nor the strains themselves are inventive (see paragraphs 4 and 5 of this Item) the subject-matter of claim 16 lacks an inventive step (Article 33(3) PCT).

- 7.2. Furthermore, it has to be mentioned that Claim 16 defines a product by the process with which it is obtained (product-by-process). Applicant's attention is drawn to the fact that the jurisprudence of the member states is not homogenous with respect to this type of claims. Under the EPC novelty would be recognized only if the product itself is distinguishable from others in the prior art.

**Re Item VI (certain documents cited)**

1. Certain published documents (Rule 70.10)

Application No Patent No	Publication date (day/month/year)	Filing date (day/month/year)	Priority date (valid claim) (day/month/year)
PCT/CU98/00008	15.07.99	30.12.98	30.12.97

**Re Item VII and VIII (form or content and clarity)**

1. The subject-matter of claim 2 characterised by the expression " $\Delta$  *thyA* strain" is not restricted to strains obtainable by the method of claim 1 but embraces also other mutant strains lacking functionality of the *thyA* gene. This could lead to novelty objections. In order to avoid such objections the mentioned expression should be clearly defined.
2. The expression "essentially" used e.g., in claims 1 and 9 lacks clarity. A definition as given in page 3, I.11-14 used in the claims could overcome said objection.
3. The term "gene nucleotides" used in claim 1 is not clear without a definition of the gene in question (Article 6 PCT).